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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YASUTAKA NISHIMURA, AKIRA OHKADO, and
TADASHI TSUMURA

Appeal 2014-006266¹
Application 13/564,858²
Technology Center 3600

Before HUBERT C. LORIN, BRADLEY B. BAYAT, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–17. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM but designate the affirmance as a NEW GROUND OF REJECTION.

¹ Our decision references Appellants' Appeal Brief ("App. Br.," filed Nov. 7, 2013) and Reply Brief ("Reply Br.," filed Apr. 24, 2014), and the Examiner's Answer ("Ans.," mailed Mar. 6, 2014), and Final Office Action ("Final Act.," mailed Aug. 9, 2013).

² Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relates to a method of managing an access right, and to a system and a computer program for the same." Spec.

¶ 2.

Claim 1, reproduced below, is the sole independent claim and is representative of the subject matter on appeal:

1. A method to manage an access right to at least one asset associated with at least one work order in a digital format, to at least one first element associated with the at least one asset, or to at least one second element associated with an access path to the at least one asset or the first element, the method comprising steps executed by a computer of:

at a scheduled start time for a work order to be executed, or in response to reception of a report indicating a start of work for the work order or a report indicating a completion of work for a preceding work order to the work order, the computer loading the work order into a memory of the computer, and authorizing a worker entity, designated in the loaded work order, to have an access right to the at least one asset, the first element or the second element associated with the work order; and

revoking a granted access right at a scheduled completion time for a work order already started, or in response to reception of a report indicating the completion of work for the work order already started or a report indicating the start of a succeeding work order to the work order already started.

REJECTIONS

Claims 1–17 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 3, 4, and 6–17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mitchell (US 8,321,253 B2, iss. Nov. 27, 2012) and Ratcliff (US 2008/0163347 A1, pub. July 3, 2008).

Claims 2 and 5 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mitchell, Ratcliff, and Clerc (US 2005/0010756 A1, pub. Jan. 13, 2005).

ANALYSIS

Non-Statutory Subject Matter

Appellants argue claims 1–17 as a group. App. Br. 6–7; *see also* Reply Br. 2–3. We select independent claim 1 as representative. The remaining claims stand or fall with claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv).

In rejecting claim 1 under 35 U.S.C. § 101 the Examiner asserts that “based on Supreme Court precedent . . . and recent Federal Circuit decisions, a § 101 process must (1) be tied to a particular machine or apparatus (machine implemented); or (2) particularly transform a particular article to a different state or thing.” Final Act. 3–4; *see also* Ans. 2–3, 13–14. The Examiner cites to *Bilski v. Kappos*, 130 S. Ct. 3218 (2010) for the proposition that the tie to a particular apparatus cannot be mere extra-solution activity. Final Act. 4; *see also* Ans. 3, 14.

But in *Bilski* the Supreme Court held that “the machine-or-transformation test is not the sole test for deciding whether an invention is a patent eligible ‘process’ under § 101.” *Bilski*, 130 S. Ct. at 3221. The test nonetheless remains “a useful and important clue or investigative tool.” *Id.*

More recently, in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court further clarified the law regarding patent eligible subject matter. In doing so, the Supreme Court reiterated the two-step framework, previously set forth in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing

patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.”

Alice Corp., 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” *id.*, e.g., to an abstract idea. If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297). We apply this framework in our analysis.

Turning to step one of the *Alice* analysis, claim 1 recites a method to manage an access right comprising the steps of: (1) loading a work order into a memory of a computer, (2) authorizing a work entity designated in the work order to have an access right, and (3) revoking a granted access right. Appellants’ Specification describes a work entity as “a person or a robot that performs the work on the basis of a work order.” Spec. ¶ 38. The Specification describes that

[a]n object of the invention is to give a worker associated with a work order an access right to an asset while the worker is performing management and maintenance work in accordance with the work order.

Id. ¶ 10. Based on the claim language and the Specification, we agree with the Examiner that claim 1 is directed to the abstract idea of access right management. Ans. 13.

Because we find that claim 1 is directed to an abstract idea, the claim must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements that is sufficient to ensure

that the claim in practice amounts to significantly more than the abstract idea of managing an access right. Here, we find no additional claim element or combination of elements that transforms the nature of the claim into a patent-eligible application of the abstract idea.

Claim 1 additionally recites in the preamble that the steps of the method are “executed by a computer,” and the claim further recites “loading the work order into a memory of a computer.” But loading data, such as a work order, into memory is nothing more than a conventional function that can be performed by a generic computer. We are unable to discern any use of a computer in claim 1 that would deviate from its well understood, routine, and conventional use. Thus, we agree with the Examiner that Appellants’ claim 1 is not sufficiently tied to a particular machine or apparatus nor involved in any type of transformation. Final Act. 4. *See Alice*, 134 S. Ct. at 2359 (“the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention). Claim 1 neither purports to improve computer functioning nor does it otherwise “effect an improvement in any other technology or technical field.” *Id.*

In view of the foregoing, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of claim 1. We also sustain the rejection under 35 U.S.C. § 101 of claims 2–17, which fall with claim 1. Because the Examiner’s reasoning was not consistent with the *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, which was in effect before the mailing of the Final Office Action, we denominate this a new ground of rejection.

Obviousness

Independent Claim 1 and Dependent Claims 3, 4, and 6–17

We are persuaded that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because Mitchell fails to disclose or suggest

at a scheduled start time for a work order to be executed, or in response to reception of a report indicating a start of work for the work order or a report indicating a completion of work for a preceding work order to the work order, the computer loading the work order into a memory of the computer, and authorizing a worker entity, designated in the loaded work order, to have an access right to the at least one asset, the first element or the second element associated with the work order[,]
as recited in claim 1. App. Br. 8–14; *see also* Reply Br. 4–5.

Mitchell is directed to a technician control system configured to control scheduling and dispatch operations for work orders handled by technicians associated with a client. Mitchell, col. 1, ll. 27–40. A scheduling application assigns unscheduled work orders to one or more field technicians associated with a client. *Id.* at col. 12, ll. 19–24. The scheduling application includes a process for assisting a supervisor to address scheduling issues. *Id.* at col. 29, ll. 25–27. The process includes monitoring progress of the work order, and sending a message to the supervisor regarding any scheduling issue. *Id.* at col. 29, ll. 27–39, 62–63; col. 30, ll. 54–56. Each client has a defined, segregated data area. *Id.* at col. 35, ll. 24–27. Admission rights and privileges are set for the client to enable users to access the segregated data area. *Id.* at col. 35, ll. 35–37. The admission rights may be based on a role of the user, such as whether the user is a scheduler, supervisor, or technician of the client. *Id.* at col. 35, ll. 37–39. The admission rights also may be tied to hardware information of technician

devices used by technicians of the client such that only technicians physically possessing a technician device associated with a particular client are able to access the particular client's data. *Id.* at col. 35, ll. 47–51.

In rejecting claim 1, the Examiner finds, and we agree, that because the claimed loading and authorizing occur in response to one of three alternatives, the prior art only needs to teach one of the claimed features.

Ans. 15. The Examiner finds that Mitchell's disclosure at column 12, lines 17–37

teaches the reception of a report scheduling a work order and is therefore sufficient to teach the claimed feature of “in response to reception of a report indicating a start of work for the work order[.]”

Id. at 16. And the Examiner concludes that

Mitchell's disclosure of setting [an] access right to a client's data at least teaches the claimed feature of “authorizing a worker entity, designated in the loaded work order, to have an access right to the at least one asset, the first element or the second element associated with the work order[.]”

Id. at 17.

To put it another way, the Examiner finds that Mitchell describes both (1) receiving a report indicating a start of work and (2) authorizing a worker entity to have an access right and, thus, reasons that Mitchell discloses the argued limitation. The difficulty with the Examiner's analysis, as noted by Appellants, is that claim 1 recites that authorizing occurs “at a scheduled start time for a work order to be executed, or in response to reception of a report indicating a start of work for the work order or a report indicating a completion of work for a preceding work order to the work order,” and Mitchell's authorizing is not tied to any such event. Instead, Mitchell

describes setting access rights for a client upon establishing a client based on user roles or hardware information.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner's rejection of dependent claims 3, 4, and 6–17. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

Dependent Claims 2 and 5

Claims 2 and 5 depend from independent claim 1. The Examiner's rejection of these dependent claims does not cure the deficiency in the Examiner's rejection of independent claim 1. Therefore, we do not sustain the Examiner's rejection of dependent claims 2 and 5 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to the independent claim.

DECISION

The Examiner's rejection of claims 1–17 under 35 U.S.C. § 101 is affirmed. We demonstrate our affirmance a new ground of rejection under 37 C.F.R. § 41.50(b).

The Examiner's rejections of claims 1–17 under 35 U.S.C. § 103(a) are reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the Examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the *Manual of Patent Examining Procedure* § 1214.01.

AFFIRMED; 37 C.F.R. § 41.50(b)